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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/608,580	06/27/2003	Robert A. Bellman	SP01-346A	8415

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CORNING INCORPORATED
SP-TI-3-1
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EXAMINER	
HOFFMANN, JOHN M	

ART UNIT	PAPER NUMBER
1731	

DATE MAILED: 08/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/608,580	BELLMAN ET AL.	
	Examiner	Art Unit	
	John Hoffmann	1731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *28 June 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,2,4-6,9-13 and 26-29* is/are pending in the application.

4a) Of the above claim(s) *5,9,10,27 and 29* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,2,4,6 and 13* is/are rejected.

7)☒ Claim(s) *11,12,26 and 28* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

Applicant's election with traverse of Species A1, B1, C2, D1 and E2 in the reply filed on 28 June 2005 is acknowledged. The traversal is noted however the relevance of the arguments is not understood. The only ways that Examiner is aware of that will properly cause the removal of an election is 1) show the species are not mutually exclusive, 2) clearly admit on the record that the species are obvious variants of each other, or 3) provide evidence that the species are obvious variants of each other. Applicant has not provided any of these.

The requirement is still deemed proper and is therefore made FINAL.

Claims 5, 9-10, 27 and 29 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected specie, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 28 June 2005.

Claim Objections

The claims are objected to because of the following informalities: The font used is too small for the quality of fax transmission provided. The format that applicant provided makes reading difficult – especially subscripts and the like. It is presumed that a higher quality fax machine or larger font would correct the problem. Most notably line 1 of claim 1 suggests that "a" of "on a surface" is deleted by being lined through. Appropriate correction is required.

Claims 11-12, 26 and 28 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim.

Claim 1 requires one of 4 possible ratios- each of which is stochiometric.. Claim 11 requires that the ratios be non-stochiometric. These are mutually exclusive limitations. Claim 11 does not limit claim 1, rather it takes to an entirely different scope. Claim 26 has the same problem. Claims 11-12, 26 and 28 are not further treated on the merits.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-2, 4, 6, and 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 2, it is unclear whether "R" is suppose to be "R_3". Or: in claim 1: it is unclear if in "R_3" is suppose to be an indicating subscript – or if there are suppose to be 3 R-groups.

Claim 13: there is no antecedent basis for "the organometallic compound".

The preamble of claim 1 requires "growing" a doped glass layer as well as depositing a doped glass layer. It is unclear if they are the same layer. It would seem that growing and deposing are two mutually exclusive things.

Claim Rejections - 35 USC § 103

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1 are rejected under 35 U.S.C. 103(a) as being unpatentable over Levene 3640093 in view of Suto 4414012 and Official Notice.

Examiner takes Official Notice that it is well known that one can make money by selling optical fibers.

It is deemed that the term "alkyl moiety" encompasses every moiety that comprises an alkyl. Therefore any RO- is an alkyl moiety (if R is an alkyl) because it is moiety that comprises an alkyl. See also col. 6, lines 19-24 of Dawes 6144795 (one common inventor with present application) which has non-alkyl's which are deemed to be alkyl moieties.

Col. 5, line14 of Levene discloses a compound that reads on the present compound. But Levene does not disclose "growing" anything with it. Levene does not disclose any particular use for the glass powder created –except to form glass (see col. 10, line 5-7 as well as claim 1.)

In Suto: in the "Background of the Invention" portion – various disadvantages for making doped glasses are discussed – most of all, production efficiency and rate of production. Suto teaches to use titanium as a dopant (col. 4, line 22) - Applicant also admits this is known as per [0007]. Figure 3 of Suto and the associated text of Suto discloses growing on a substrate as claimed. It would have been obvious to add the

Suto fiber growing process to the Levene process, so that one can make fibers, overcome the known problems (as disclosed by Suto) and thus make money.

Alternatively, one can use Suto as the primary reference: It would have been obvious to use the Levene process to make the Suto glass powder for the advantages at Levene (col. 2, lines 66-75).

Allowable Subject Matter

Claims 2, 4, 6, and 13 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Levene '918, Fleming (both), Bhandarkar, Thomas, Clasen, Dobbins, Schermerhorn, Nakamura, Heany, Franel, Lamberti, Nakano, Okamoto, ~~and~~ ~~Shinetsu~~ are cited as being somewhat similar to applicant's process.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Hoffmann whose telephone number is (571) 272 1191. The examiner can normally be reached on Monday through Friday, 7:00- 3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steve Griffin can be reached on 571-272-1189. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

8-1-05

John Hoffmann
Primary Examiner
Art Unit 1731

jmh